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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,609	02/04/2000	David L. Hecht	07447.0016-00000	9053

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EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/498,609

Applicant(s)

HECHT ET AL.

Examiner

Jamara A. Franklin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Acknowledgment is made of the receipt of the amendment filed on 3/13/02. Claims 1-32 are currently pending.

#### ***Claim Objections***

1. Claims 1 and 17 are objected to because of the following informalities:  
  
in claim 1, line 5, substitute the first occurrence of "the" with --an--, and  
  
in claim 17, line 6, substitute the first occurrence of "the" with --an--.  
  
Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 9-12, 16-19, 25-28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nukui et al. (US 5,945,661) (hereinafter referred to as 'Nukui') in view of Hecht (US 5,825,933) and Salive et al. (US 5,725,253) (hereinafter referred to as 'Salive').

Nukui teaches a data symbol reading device 1 for reading a data symbol 37, having an indication section 18 which notifies the device 1 user of a positioning condition of the device 1 relative to a symbol reading area 36 of the data symbol 38 on a surface 37 (col. 11, lines 18-33). The device 1 also features an operation switch 14, two light sources 41, and a charge coupled device 43 (col. 5, lines 29-31).

Nukui lacks the teaching of coded embedded data.

Hecht teaches a glyph code pattern 21 written on a suitable recording medium 24, whereas data encodings are transversely interlaced with spatial addressing information (col. 6, lines 38-42).

One of ordinary skill in the art would have readily recognized that a glyph code may store a large amount of data that is hidden and is undetectable with unaided eye, thereby causing dishonest and unauthorized decoding of the code more difficult. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Nukui with the coded embedded data as taught by Hecht.

Nukui/Hecht lack the teaching of data related to an orientation of the substrate.

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Salive teaches indicia which carries information indicating an orientation of a label upon which the indicia is printed (col. 11, lines 1-9).

One of ordinary skill in the art would have readily recognized that capturing data related to the orientation of the substrate would have been beneficial to the invention of Nukui/Hecht since it would have provided means for possibly discovering whether the substrate is properly positioned. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the teachings of Nukui/Hecht with the aforementioned teachings of Salive.

5. Claims 4-8, 13-15, 20-24, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nukui/Hecht/Salive as applied to claim 1 above, and further in view of Wang et al. (US 5,513,264) (hereinafter referred to as 'Wang'). The teachings of Nukui/Hecht/Salive have been discussed above.

Nukui/Hecht/Salive lack the teaching of the viewing area comprising a display for displaying an image based on the coded embedded data.

Wang teaches a decoding system 30 having a display unit 34 arranged to display a visual representation of a dataform (col. 5, lines 4-13). Following decoding, a displayed visual representation of the decoded data may be provided (fig. 8 and col. 9, lines 13-15).

One of ordinary skill in the art would have readily recognized that a display would have been beneficial on the scanner for allowing the user to readily view the code and decoded data as a means to ensure that one has properly carried out the scanning process. Therefore, it would

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have been obvious, at the time the invention was made, to modify the teachings of Nukui/Hecht/Salive with the display as taught by Wang.

*Response to Arguments*

6. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

The examiner has submitted the newly cited Salive reference that reads upon the newly claimed limitations of claims 1 and 17.

*Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (703) 305-0128. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jamara A. Franklin  
Examiner  
Art Unit 2876

JAF  
May 6, 2002

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
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